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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/729,159

12/08/2003

Kia Silverbrook

BAL73US

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EXAMINER

LE, QUANG V

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/729,159	Applicant(s) SILVERBROOK ET AL.	
	Examiner QUANG V. LE	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/113,057.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/08/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the application 10/729159 filed on 12/08/3003.
2. **Claims 1-30** have been examined and are pending.

Information Disclosure Statement

3. An initialed and dated copy of Applicant's IDS form 1449 filed 12/08/2003 is attached to the instant office action.

Priority

4. Acknowledgment is made of applicant's claim for priority PO 07986 under 35 U.S.C. 119(a)-(d) based upon an application 09/113,057 on 07/10/1998. However, a certified copy of PO7991 has not been received with application 09/113,057 as recited in the Oath declaration data sheet of this application. Therefore, this application is not entitled to the PO7991 priority.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 2, 8, 14, 15 and 16 of instant application are rejected under the judicially created doctrine of “obviousness type” double patenting as being unpatentable over claims 1, 4, 5, 6, 10 and 12 of US Patent No. 7,187,404.

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of the 7404' US Patent. Claim 1 of the instant application is broader in every aspect than the corresponding claims 1 of the 7404' Patent and is therefore an obvious variant thereof. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 2 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of the 7404' US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10 and 12 of the 7404' US Patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 14 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of the 7404' US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 15 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of the 7404' US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 16 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 6 of the 7404' US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

8. **Claim 1** of instant application is rejected under the judicially created doctrine of "obviousness type" double patenting as being unpatentable over claim 1 of copending application No. 10/729098, in view of Suzuki US Patent 5,847,836. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of 9098' recites most same subject matter as discussed in claim 1 of instant application, except it does not include a print manager for controlling the printing of manipulated images. Suzuki reference teaches a printer-built-in camera (col 4, line 11-12).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Suzuki built-in printer into Sarbadhikari camera

system so as to provide camera that can conveniently print out an image immediately after the image is captured.

9. Claims 6, 8, 12 and 13 of instant application are rejected under the judicially created doctrine of “obviousness type” double patenting as being unpatentable over claims 1, 2, 4, 11 and 12 of copending application No. 10/729098.

Claim 6 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of the 9098’ US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 and 4 of the 9098’ US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 12 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 11 of the 9098’ US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 13 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 12 of the 9098’ US Patent. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-7 and 14, 19-22, 22 and 27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari et al. US Pat. No. 5,477,264, further in view of Suzuki US Patent 5,847,836.

As per claim 1, Sarbadhikari teaches a handheld camera, said camera comprising: a sensor adapted to sense an image (col 4, line 3-4); and, a processing system comprising: a camera manager for controlling the sensing of the image; an image processing manager for manipulating the image (col 4, line 6-8 and col 5 line 26-30); however, Sarbadhikari fails to disclose the camera comprises a print manager for controlling printing of the manipulated image.

Suzuki, teaches a printer-built-in camera (col 4, line 11-12).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Suzuki built-in printer into Sarbadhikari camera system so as to provide camera that can conveniently print out an image immediately after the image is captured.

As per claim 19, this claim recites what was previously discussed in claim 1.

As per claim 2, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 1, Suzuki further teaches the camera comprising a printer for printing the manipulated images on media dispensed from a print roll, the print manager being adapted to control the printer (col 6, line 9).

As per claim 20, this claim recites what was previously discussed in claim 2.

As per claim 3, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 1, Sarbadhikari further teaches the camera further comprising a user interface having at least one user input and one user output, the processing system comprising a user interface manager for controlling the user interface (col 5, line 26-29).

As per claim 21, this claim recites what was previously discussed in claim 3.

As per claim 4, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 3, Sarbadhikari further teaches the user interface manager being adapted to cooperate with the camera manager to allow images to be sensed in accordance with commands received via the user interface (col 4, line 1-4 and col 5, line 26-29).

As per claim 5, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 1, Sarbadhikari further teaches the processing system comprising a file manager, the file manager being adapted to control the storage of images in a storage device (col 4, line 37-56).

As per claim 6, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 1, Sarbadhikari further teaches the camera further comprising an input for receiving predetermined data (col 5, line 26-30), the image processing manager being adapted to manipulate the images in accordance with the received predetermined data (col 4, line 6-8).

As per claim 22, this claim recites what was previously discussed in claim 6.

As per claim 7, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 6, Sarbadhikari further teaches the processing system comprising an input controller, the input controller being adapted to control the input to thereby determine the predetermined data (col 7, line 44-49).

As per claim 14, Sarbadhikari teaches a handheld camera as claimed in claim 1, Suzuki further teaches the camera comprising a guillotine the print manager being adapted to activate the guillotine to cut media from the print roll (col 6, line 11-12). The sheet cutter is the guillotine as cited in the claim.

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Suzuki built-in printer into Sarbadhikari camera system so as to provide camera that can conveniently print out an image immediately after the image is captured.

As per claim 27, this claim recites what was previously discussed in claim 14.

11. Claims 8, 9, 12, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari and Suzuki as applied to claim 6 above, and further in view of Dutton et al. US Pat. No. 4724307.

As per claim 8, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 6, but they fail to disclose that the card reader is a card drive system.

However, Dutton teaches the input comprising a card reader having a card drive system for driving the card along a card path (col 6, line 43), and a card sensor extending across the width of the card path (col 5, line 65-68), the input controller being adapted to activate the card sensor and the drive system to thereby detect the predetermined data as the card moves with respect to the card sensor (col 2, line 13-14).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Dutton card reader system into Sarbadhikari

camera so as to provide a camera system that allows the user to scan a card into the camera without using a PC. Such camera can be used as a rental camera and the customer can pay by scanning the credit card through the camera.

As per claim 23, this claim recites what was previously discussed in claim 8.

As per claim 9, Sarbadhikari, Suzuki and Dutton teach a handheld camera as claimed in claim 8, Sarbadhikari further discloses the input controller being for: determining a card image in accordance with signals received from the card sensor; selectively rotating the card image (col 11, line 3-5); and, converting the card image to determine the predetermined data (col 6, line 5-9).

As per claim 24, this claim recites what was previously discussed in claim 9.

As per claim 12, Sarbadhikari, Suzuki and Dutton teach a handheld camera as claimed in claim 8, Dutton further discloses the camera comprising a card insertion sensor, the input controller being responsive to the card insertion sensor to activate the card drive system (col 5, line 55-57 and col 6, line 51-54).

12. Claims 11 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, Suzuki and Dutton as applied to claim 9 above, and further in view of Chida et al. US Pat. No. 5,524,194.

As per claim 11, Sarbadhikari, Suzuki and Dutton teach a handheld camera as claimed in claim 9, but they fail to disclose the input controller being for: decoding the card image to determine a decoded card image data; converting the decoded card image into byte data; unscrambling the byte data to determine the predetermined data; and, performing error detection.

However, Chida teaches a camera with a video interface unit that encodes and decodes the image signal and also performs error detection (col 4, line 59-63)

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Chida decoding and error detection method into Sarbadhikari, Suzuki and Dutton camera system since it is well know in the art that encoded data is safe and secured.

As per claim 26, this claim recites what was previously discussed in claim 11.

13. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari, Suzuki and Dutton as applied to claim 8 above, and further in view of Soltesz et al., US Pat. 5,756,978.

As per claim 13, Sarbadhikari, Suzuki and Dutton teach a handheld camera as claimed in claim 8, they fail to disclose the camera comprising an ejection input, the

input controller being adapted to activate the card drive system to thereby eject the card in response to activation of the ejection input.

However, Soltesz discloses a sale terminal that has an eject key **38** that ejects the optical card from card reader **1** upon activation (col 6, line 6-9).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate Soltesz card ejection system into Sarbadhikari, Suzuki and Dutton camera system with card reader since it is known in the art that a card reader has to have an eject function so the card can be removed at user command.

14. **Claims 17, 18, 29 and 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbadhikari and Suzuki as applied to claim 1 above, further in view of Peyret, US Patent 5,688,056.

As per claim 17, Sarbadhikari and Suzuki teach a handheld camera as claimed in claim 1, Suzuki further teaches the camera comprising a housing adapted to receiving a print roll for dispensing media on which images are printed, however, they fail to disclose the print roll comprising a print roll authentication chip comprising authentication information stored thereon, the print manager being adapted to: authenticate the print roll in accordance with the authentication information; and, print the image in accordance with a successful authentication.

Peyret teaches a detachable printer cartridge that contains security mark (chip card 124, col 6, line 49-57) determined automatically by a secured method enabling the franking mark to be authenticated (col 3, line 28-29 and).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to incorporate the authenticated printer cartridge with the camera printer, since the examiner takes official notice of the equivalence of the print roll and print cartridge for their use in the printing art and the selection of any of these known equivalents would be within the level of ordinary skill in the art.

As per claim 29, this claim recites what was previously discussed in claim 17.

Regarding claim 18, Sarbadhikari, Suzuki and Peyret teach a handheld camera as claimed in claim 17, Peyret further discloses the print manager being adapted to perform the authentication by: generating a challenge; transferring the challenge to the print roll authentication chip, the print roll authentication chip being responsive to the challenge to generate a response; receiving said response; and, authenticating the print roll in accordance with the response (col 4, line 28-32).

As per claim 30, this claim recites what was previously discussed in claim 18.

Allowable Subject Matter

15. Claims 10,15, 16, 25 and 28 are objected to as being dependent upon their rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

Regarding claims 10 and 25, no prior art could be located that teaches or fairly suggests a handheld camera with card image that selectively rotates in accordance with the skew of the card with respect to the card sensor.

Regarding claims 15 and 28, no prior art could be located that teaches or fairly suggests a handheld camera with a print manager being adapted to activate the guillotine in response to the print roll sensor adapted to detect an attempt to pull media from the camera.

Regarding claim 16, no prior art could be located that teaches or fairly suggests a handheld camera with the print manager being adapted to activate the guillotine if the print roll sensor indicates media is being dispensed at a rate greater than that of the print roll drive system.

Conclusion

16. The prior arts made of record and not relied upon are considered pertinent to applicant's disclosure:

Alasia; Alfred V. BAILEY J S et al.	(US 4092654 A) Encoding system (US 3893173 A) Miniature magnetic card reader and recorder for hand-held calculator, is activated by thickness of card, conforms card to head
Berger; Erich et al.	(US 4740269 A) Process and apparatus for applying authenticating coding to value-carrying paper

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BILBREY B et al.	(US 6020931 A) Video signal composition system for media signal communication systems, advanced display systems
Bilbrey; Brett et al.	(US 6020931 A) Video composition and position system and media signal communication system
HIEDA T et al.	(US 6278486 B 1) Image signal processor for video camera system, reproduces different image data in predefined order, based on the selected scenario data, which is combined with generated image
Hieda; Teruo et al.	(US 6278486 B1) Information signal controlling system
Koyabu; Akira	(US 5819662 A) Printer
Stephenson; Stanley W.	(US 5909248 A) Exposure control of camera attached to printer electronic camera

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang V. Le whose telephone number is (571) 270-5014. The examiner can normally be reached on Monday through Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr David Ometz can be reached on (571) 272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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